<u>REMARKS</u>

Correction

The Office Action of August 4, 2004, (hereinafter the "Office Action") indicates that claims 1-50 are pending. However, only claims 1-4, 7-16 and 19-50 are pending because claims 5-6 and 17-18 were canceled in the Amendment filed November 20, 2003.

Allowable Subject Matter

Claims 1-25 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, as set forth in the Office Action. Claims 30-32, 34-36, 42-44, and 46-48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicants appreciate the Examiner's diligent work and designation of allowable subject matter but respectfully submit that the remaining claims are also allowable as explained below. As noted above, only claims 1-4, 7-16, and 19-25 are pending out of claims 1-25.

Section Numbering

Applicants' following remarks are numbered to correspond with those in the Office Action of August 4, 2004, for ease of tracking.

Drawings

2.   The drawings are objected to under 37 CFR 1.83(a).

The Examiner states in the Office Action:

> "The drawings must show every feature of the invention specified in the claims. Therefore, the <u>interactions</u> of the "legacy system", "non-legacy system", "computer system", and "microdevices" as shown in the independent claims must be shown or the feature(s) canceled from the claim(s)." [underlining for clarity]

It is respectfully submitted that "interactions" relate to the claimed method and since pending claims 1-4, 7-16 and 19-50 are method claims, drawings are not required. MPEP 601.01(f) states in relevant part:

> "...35 U.S.C. 113 (first sentence) in turn provides that an "an applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.
>
> ...
>
> It has been USPTO practice to treat <u>an application that contains at least one process or method claim as an application for which a drawing is not necessary</u> for an understanding of the invention under 35 U.S.C. 113 (first sentence). ..." [underlining for clarity]

Withdrawal of the objection is respectfully requested.

Claim Rejections - 35 USC §112

3.   Claims 1-50 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Initially, it is respectfully submitted that the Examiner's rejections are apparently based on the belief that the claims must disclose all aspects of the invention. However, it is respectfully submitted that pending claims 1-4, 7-16 and 19-50 are allowable because it has long been settled that:

> "[B]y statute, 35 U.S.C. 112, Congress has placed no limitations on *how* an applicant claims *his invention*, so long as the specification concludes with claims which particularly point out and distinctly claim that invention." *In re* Pilkington, 411 F.2d 1345, 1349-50, 162 USPQ 145, 148 (C.C.P.A. 1969) (quoting *In re* Steppan, 394 F.2d 1013, 1019, 156 USPQ 143, 148 (C.C.P.A. 1967) (emphasis in original). "Moreover, <u>it is not the normal function of a claim to disclose the invention, but to point out the features of novelty in the invention as disclosed in the specification and drawing of the application</u>." Bocciarelli v. Huffman, 232 F.2d 647, 109 USPQ 385, 388 (C.C.P.A. 1956). A claim is not defective when it states fewer than all of the steps that may be performed in practice of an invention. Smith & Nephew, Inc., v. Ethicon, Inc., 276 F.3d 1304, 61 USPQ2d 1065, 1069 (Fed. Cir. 2002) (citing Moleculon Research Corp. v. CBS, Inc., 793 F.2s 1261, 1271, 229 USPQ 805, 812 (Fed. Cir. 1986)).

Based on the above, it is respectfully submitted that Applicants have pointed out the features of novelty in the claims 1-4, 7-16 and 19-50 and thus the claims are allowable under 35 U.S.C. §112, second paragraph.

More specifically, each of the groups of rejected claims is addressed below

With reference to claims 1, 13, 26, and 38, the Examiner states in the Office Action:

> "[P]rocessing microdevices" (line 26) is indefinite because it is not made explicitly clear in the claim language if the computer, legacy, and/or the non-legacy system processes the microdevices."

Applicants respectfully disagree. It would be obvious to those having ordinary skill in the art that the legacy and non-legacy processing systems process the microdevices since claim 1, lines 22-23, and claim 13, lines 22-23, state:

> "providing the number of <u>processed microdevices to be output from the legacy processing system and the non-legacy processing system</u>;" [underlining for clarity]

From the above, the legacy and the non-legacy systems can both output processed microdevices.

With regard to claims 26 and 38, it would be obvious to those having ordinary skill in the art that the <u>task</u> instructs the legacy and non-legacy (programmer feeder) systems as the Specification describes in page 3, lines 24-26:

> "The present invention provides a task linking program for using a computer for interacting with on-line and off-line processing systems to perform tasks related to processing microdevices."

Based on the above, withdrawal of the rejections is respectfully requested.

a.   With reference to claims 1, 13, 26, and 38, the Examiner states in the Office Action:

> " '[N]on-legacy processing system for operating independently from the computer' (lines 5-6) is indefinite because in line 9, the computer system provides the task to the non-legacy system and in line 14, the return non-legacy information is returned from the non-legacy system to the computer. In addition, "returning the return non-legacy information to the computer system" is indefinite because it is not made clear in the claim language how this can occur if the non-legacy processing system is supposed to be independent of the computer system."

Applicants respectfully disagree. A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. Applicants have defined "operating independently" in Specification page 4, lines 26-28:

> "And third, is the new processing system, such as a programmer/feeder system, which is <u>generally off-line</u> or generally <u>operates independently</u> from the computer system." [underlining for clarity]

Thus, it would understood by those having ordinary skill in the art that the non-legacy system operates independently from the computer system but can receive a task and return information from the computer system while operating independently the rest of the time. As noted by the Court in *In re* Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

Based on the above, withdrawal of the rejection is respectfully requested.

b.   With reference to claims 1, 13, 30, 34, 42, and 46, the Examiner states in the Office Action:

> " 'providing processing system setup and shutdown parameters' (line 15) and 'providing the processing system process-specific parameters' (line 16) because it is not made explicitly clear in the claim language whether the legacy, non-legacy, computer system, or microdevices is performing these features."

Applicants respectfully disagree. Without being limiting, the Specification page 4, lines 23-18, states:

> "The present invention relates to an overall system (not shown) which consists of three basic systems. First, is the computer system in which the program of the present invention operates. Second, is the legacy processing system, such as a programming system, which is on-line with the computer. And third, is the new processing system, such as a programmer/feeder system, which is generally off-line or generally operates independently from the computer system."

It would be obvious to those having ordinary skill in the art that the computer system provides the parameters since these parameters are provided to and used by the legacy and non-legacy systems as claimed in claim 1, lines 18-25, for example, which states:

> "providing the processing system <u>setup</u> parameters <u>to the legacy processing system and the non-legacy processing system</u>;

> providing the processing system <u>shutdown</u> parameters <u>to the non-legacy</u>
> <u>processing system simultaneously with the processing system setup</u>
> <u>parameters</u>;
>
> ...
>
> providing processing system <u>process-specific</u> parameters <u>to the legacy</u>
> <u>processing system and the non-legacy processing system;</u>" [underlining
> for clarity]

However, it will be understood that the features of novelty comprise providing the noted parameters to the noted systems.

Claims 13, 30, 34, 42, and 46 contain similar language.

Based on the above, withdrawal of the rejection is respectfully requested.

c.   With reference to claims 1 and 13, the Examiner states in the Office Action:

> "[T]here is no link or relationship established between, "non-legacy
> information" (line 14) and "system setup and shutdown parameters" (line 15)
> and "system process-specific parameters" (line 16), and therefore, it is not
> made explicitly clear in the claim language whether or not "non-legacy
> information" constitutes "system setup and shutdown parameters" and "system
> process-specific parameters."

Applicants respectfully disagree. It would be obvious to those having ordinary skill in the art that since there is no link or relationship established between "non-legacy information" (line 14) and "system setup and shutdown parameters" (line 15) and "system process-specific parameters" (line 16), no link or relationship is required. The non-legacy information stands separately from the setup, shutdown, or process-specific parameters as indicated by the claim 1, lines 13-15:

> <u>developing</u> return <u>non-legacy information</u> resulting <u>from the non-legacy</u>
> <u>processing system</u> using the task;
> <u>returning the return non-legacy information to the computer system;</u>"

Based on the above, withdrawal of the rejection is respectfully requested.

d.   With reference to claims 1 and 13, the Examiner states in the Office Action:

> "'[P]roviding the number of processed microdevices to be output from the
> legacy processing system and the non-legacy processing system" (line 21) and
> "providing processing system process-specific parameters to the legacy
> processing system and the non-legacy processing system" (line 23) is

indefinite because it is not made explicitly clear in the claim language whether
the microdevices or computer system provides this."

Applicants respectfully disagree. It would be obvious to those having ordinary skill in the art from the phrases quoted by the Examiner that the overall system, without being limiting, comprises three basic systems: the legacy processing system, the non-legacy processing system, and the computer system. Since the number and the parameters are provided to two of the three basic systems, by process of elimination if no other, the third basic system, the computer system, provides the number and parameters. As would be evident to those having ordinary skill in the art, the microdevices first appear in the preamble of the claim to indicate that they are not an element of the claimed invention.

Based on the above, withdrawal of the rejection is respectfully requested.

e.   With reference to claims 13, 26, 30, 34, 38, 42, and 46, the Examiner states in the Office Action:

"Claims 13, 26, 30, 34, 38, 42, and 46 had the same deficiency as claim
1 above. Corrections to claim 1 are also required to overcome the rejection for
these claims."

Based on all of the above, it is respectfully submitted that claims 1-4, 7-16 and 19-50 are allowable under 35 U.S.C. §112, second paragraph, for the same reasons as claim 1.

Claim Rejections - 35 USC §103

5.   Claims 26-29 and 37 are rejected under 35 USC §103(a) as being unpatentable over Tyner et al. (USPN 6,272,618, hereinafter "Tyner"), in view of Bodnar et al. (USPN 6,658,268, hereinafter "Bodnar").

Tyner teaches a system and method for handling system management interrupts in a multi-processor computer. When the computer enters system management mode, the method uses the registers of each processor to get currently executing opcode to determine what each processor was doing before the interrupt. The contents of the registers can be used to determine if the current processor caused the system management interrupt. If so, then the method now knows which processor caused the interrupt and can handle the interrupt accordingly. If, however, the processor was not the one that caused the interrupt, or if another

processor also caused an interrupt, the method then repeats the above steps for the next processor of the multiprocessor system. Taken as a whole, Tyner teaches how interrupts are handled in a multiprocessor computer, but does not teach or suggest a system for processing microdevices.

Bodnar teaches an enhanced "Camel-back" or "Companion" Digital Organizer (CDO) is described that is designed to interface to a cellular telephone. Taken as a whole, Bodnar teaches a combined cell phone and personal organizer.

6. – 8.   As to claim 26, Applicants respectfully traverse the rejection because it is respectfully submitted that those having ordinary skill in the art would recognize that neither Tyner nor Bodnar teaches or suggests the claimed "processing", which is defined in Specification page 10, line 29, through page 11, line 2:

> "The best mode describes <u>processing</u> which is <u>programming for programmable devices</u>, which include but are not limited to devices such as Flash memories (Flash), electrically erasable programmable read only memories (E^{2}PROM), programmable logic devices (PLDs), field programmable gate arrays (FPGAs), and microcontrollers. However, the present invention encompasses <u>processing</u> for all electronic, mechanical, hybrid, and other devices <u>which require testing, measurement of device characteristics, calibration, and other processing operations</u>."

The case law holds what is described in the specification <u>is</u> considered part of the claimed limitation where an applicant defined term, such as "processing", is involved. All Dental Prodx, LLC v. Advantage Dental Prod., Inc. No. 02-1107 (Fed Cir. Oct. 25, 2002)

The Examiner states in the Office Action of August 4, 2004, (hereinafter the "Office Action):

> "Tyner teaches a method for processing microdevices comprising:"

Applicants respectfully disagree. None of the Examiner cited sections teach or suggest the claimed "processing" microdevices. Tyner teaches an interrupt signal handling scheme within a multiprocessor computer system and Bodnar teaches a combination cell phone and personal organizer would not teach one having ordinary skill in the art the claimed invention for processing a microdevice by programming, testing, measurement, calibration, etc.   As stated by the Court of Appeals for the Federal Circuit:

"Although the PTO must give claims their broadest reasonable interpretation, this interpretation must be consistent with the one that those skilled in the art would reach." *In re* Cortright, 165 F.3d 1353, 1358 (Fed. Cir. 1999), cited in *In re* American Academy of Science Tech Center, CAFC 03-1531, May 13, 2004."

The Examiner states in the Office Action:

"It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of providing the task from the computer system to the non-legacy processing system for performing the task by the non-legacy processing system independent of the computer system, developing return non-legacy information resulting from the non-legacy processing system using the task, and returning the return non-legacy information to the computer system to the existing system and method of Tyner in order to transfer instructions and information, thus making both the computer and non-legacy system "smarter" *(col. 17, lines 33-63)*."

Applicants respectfully disagree because Bodnar col. 17, lines 33-66, does not teach or suggest making a computer and a non-legacy telephone "smarter", but relates to telephone docking units which are unrelated to processing microdevices:

"Built-in docking units are docking units for non-legacy phones... To the extent that different target phones do not use a same communication protocol, a main unit that is to be docked to multiple docking units, for multiple target phones, may be loaded with...phone-model-specific... software. Upon docking..., such a main unit determines...the model of the host phone...and uses the software in the main unit's memory that is specific to the model of the host phone. In a particular embodiment, the phone-model-specific software is created and sold with each new model of docking unit... In an alternate embodiment, each docking unit may include an amount of memory (e.g., flash-based memory) that contains phone-model-specific software for instructing the main unit to work with the docking unit's compatible model(s) of phone..."

Based on the above not suggesting a motivation for the combination, it is respectfully submitted that claim 26 is allowable under 35 USC §103(a) as being unpatentable over Tyner in view of Bodnar because MPEP §2143.01 states:

"The combination of references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper. The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2s 1161 (Fed. Cir. 1999)"

Based on the above, withdrawal of the rejection of claim 26 is respectfully requested.

9. – 11.   As to claims 27-29, these dependent claims depend respectively directly or indirectly from independent claim 26 and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof.

12.   As to claim 37, the Examiner takes "Official Notice" of an administrator mode and protecting provision of the operator mode using a password input in the administrator mode, but the claimed combination is for a method for processing microdevices, which is not taught or suggested in the cited references. Applicants respectfully request an Examiner Affidavit disclosing the Examiner's personal knowledge of "Official Notice" regarding these limitations pursuant to 37 CFR §1.104(d)(2) so it may be traversed:

> "When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons."

13.   Claims 38-41 and 49-50 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tyner et al. (USPN 6,272,618, hereinafter "Tyner") in view of Bodnar et al. (USPN 6,658,268, hereinafter "Bodnar"), and further in view of Coburn et al. (US PUB 2002/0120921, hereinafter "Coburn").

Tyner and Bodnar have been summarized above. Taken as a whole, Tyner and Bodnar do not teach or suggest the combination or provide a motivation of the combination as explained above.

Coburn teaches a method, apparatus and data construct set for generating simulation data structures which can be used by a modeling system to interface between a programmable logic controller (PLC) and a movie module, the construct set encapsulating logic and at least a sub-set of simulation information for a particular resource wherein the sub-set includes simulation information which is independent of circumstantial characteristics corresponding to the resource, the method including importing the simulation information from the data

constructs and populating the data structures. Taken as a whole, Coburn teaches a "development process" of designing, constructing, and debugging a manufacturing process.

14.   As to claim 38, Applicants respectfully traverse the rejection because the Examiner incorrectly describes Coburn in the Office Action by stating:

> "Coburn teaches using a progammer/feeder (sic) system consisting of robots, computers, programmable logic controllers, mills, drills, stamps, clamps, sensors, transfer bars, assemblers, etc. because almost every industry has recognized its advantage that use of automated assembly and machining lines to form and assemble product components and assemblies reduce manufacturing time, reduces product costs, and increases product quality *(page 1, [0005])*."

Coburn page 1, para. [0005], is Background and states:

> [0005] A visit to virtually any modern manufacturing facility in the world leaves room for little doubt that assembly and machining lines have become an integral part of the manufacturing process. Robots, computers, programmable logic controllers, mills, drills, stamps, clamps, sensors, transfer bars, assemblers, etc., are more numerous than people in most modern manufacturing facilities. This is because almost every industry has recognized that use of automated assembly and machining lines to form and assemble product components and assemblies reduces manufacturing time, reduces product costs and increases product quality. Hereinafter, automated assembly and machining will be referred to collectively as automated manufacturing."

As would be obvious to those having ordinary skill in the art, a programmer/feeder both programs and feeds microdevices. Coburn para. [0005] describes any modern manufacturing facility but, as shown above, does not teach or suggest the claimed programmer/feeder. Since the limitation is not taught or suggested, Applicants respectfully request an Examiner Affidavit disclosing the Examiner's personal knowledge regarding this limitation pursuant to 37 CFR §1.104(d)(2), supra, so it may be traversed.

15. – 16.   As to claims 39 and 40, these dependent claims respectively directly or indirectly depend from independent claim 38 and are believed to be allowable since they contain all the limitations set forth in the independent claim from which they depend and claim additional unobvious combinations thereof.

17.   As to claim 41, the Examiner takes "Official Notice" of an administrator mode but the claimed combination is for a method for processing microdevices and this is not taught or suggested in the cited references. Applicants respectfully request an Examiner Affidavit disclosing the Examiner's personal knowledge of "Official Notice" regarding these limitations pursuant to 37 CFR §1.104(d)(2), supra, so it may be traversed.

18.   As to claim 49, the Examiner takes "Official Notice" of an administrator mode and protecting provision of the operator mode using a password input in the administrator mode, but the claimed combination is for a method for processing microdevices, which is not taught or suggested in the cited references. Applicants respectfully request an Examiner Affidavit disclosing the Examiner's personal knowledge of "Official Notice" regarding these limitations pursuant to 37 CFR §1.104(d)(2), supra, so it may be traversed.

19.   As to claim 50, this dependent claim depends from independent claim 38 and is believed to be allowable since it contains all the limitations set forth in the independent claim from which it depends and claims unobvious combinations thereof.

20.   Claim 33 is rejected under 35 U.S.C. §103(a) as being unpatentable over Tyner et al. (USPN 6,272,618, hereinafter "Tyner") in view of Bodnar et al. (USPN 6,658,268, hereinafter "Bodnar"), and further in view of Kenik et al. (USPN 4,821,197, hereinafter "Kenik").

Tyner and Bodnar have been summarized above

Kenik teaches system for manufacturing multiple component assemblies utilizing semi-automatic computer-assisted material handling. The system comprises a plurality of component selection cells each having an alphanumeric display to display a selected assembly model description and a plurality of component bins wherein each bin has an associated numeric display for displaying the quantity of components from that bin required for a selected assembly model. Each numeric display has a means for clearing the display after the required quantity of components has been selected and for generating a control signal in response to a completion of a selected collection of parts for that cell relating to the selected

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assembly model. A computer controls the alphanumeric and numeric displays responsive to data entered by an operator relating to the selected assembly model number and controls the clearing of the alphanumeric displays in response to the control signal.

21.   As to claim 33, Applicants respectfully traverse the rejection because the claim limitation claims a method comprising software tasks and kits. Kenik relates to hardware components. It is respectfully submitted that each reference has not been taken as whole but only portions of each reference have been combined and this is impermissible because the CAFC has stated:

> "One cannot...pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re* Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

22.   Claim 45 is rejected under 35 U.S.C. §103(a) as being unpatentable over Tyner et al. (USPN 6,272,618, hereinafter "Tyner") in view of Bodnar et al. (USPN 6,658,268, hereinafter "Bodnar"), and further in view of Coburn et al. (US PUB 2002/0120921, hereinafter "Coburn"), and further in view of Kenik et al. (USPN 4,821,197, hereinafter "Kenik").

Tyner, Bodnar, Coburn, and Kenik have been summarized above.

23.   As to claim 45, Applicants respectfully traverse the rejection.

The Examiner states in the Office Action:

> "Tyner, Bodnar, and Coburn fail to explicitly teach combining a plurality of tasks to define a kit and performing the processing of a kit through the off-line connection. However, Kenik teaches using kits to perform off-line subassemblies *(col. 5, lines* 33-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the feature of combining a plurality of tasks to define a kit and performing the processing of a kit through the off-line connection because this allows for tracking, updating and maintaining inventory *(col. 5, lines 33-44)."*

It is respectfully submitted that the claim is allowable for the same reason as for claim 38 for Tyner, Bodnar, and Coburn and as for claim 33 for Kenik.

Based on all of the above, it is respectfully submitted that claims 26-29, 33, 37, 38-41, 45, and 49-50 are allowable under 35 U.S.C. §103(a) because the cited references do not teach or suggest the claimed combinations and the CAFC has held:

> "The question is whether the prior art, considering its scope and content and the level of ordinary skill, must itself suggest the combination of separate elements into the claimed invention in suit, not just whether it illustrates separate elements..." Laitram Corp. v. Cambridge Wire Cloth Co., 226 USPQ 298 at 293n (D. Md. Mag. 1985), aff'd in part, rev'd in part, and remanded, 785 F.2d 292, 228 USPQ 935 (Fed. Cir. 1986), cert. denied, 479 U.S. 820 (1986):

Conclusion

In view of the above, it is submitted that the claims are in condition for allowance and reconsideration of the rejections is respectfully requested. Allowance of claims 1- 4, 7-16 and 19-50 at an early date is solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including any extension of time fees, to Deposit Account No. 50-0374 and please credit any excess fees to such deposit account.

Respectfully submitted,

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